REMARKS

Claims 9, 10 and 14-17 are pending. Claims 9 and 14 are amended and new claims 16 and 17 are added. A marked-up version showing the changes made by the present amendment is attached hereto as "**Version with markings to show changes made**."

Claims 9 and 10 were rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent JP 07230906A. Although the Examiner refers to this application as "JP '653", the following remarks will refer to this publication as JP '906 to avoid confusion. Favorable reconsideration of the rejection is earnestly solicited.

Claim 9 has been amended to specify that the metal oxide film contains carbon. JP '906 fails to teach or suggest forming a metal oxide film containing carbon on the surface of a rare earth metal-based permanent magnet.

Claims 14 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP '906. Favorable reconsideration of this rejection is requested in view of the amendments made herein.

Claim 14 has been amended to specify a step of forming a metal oxide film containing carbon on the surface of a magnet by a sol-gel coating process. As noted above, JP '906 does not teach or suggest forming such a film.

Claims 9 and 10 were rejected under 35 USC §101 as allegedly claiming the same invention as claims 1 and 3 of US Patent No. 6,399,147. This rejection is respectfully traversed.

In analyzing a statutory double patenting rejection, the first question in the analysis is whether the same invention is being claimed twice. Case law defines "same invention" as identical subject matter. A good test for "same invention" has been defined as whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention. In re Vogel and Vogel, 164 USPQ 619 (CCPA 1970). Thus, according to this test, the same invention is not being claimed, and therefore, the rejection should be withdrawn.

Claims 9 and 10 were also rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1 and 5 of US Patent No. 6,251,196. This rejection is traversed for the same reasons discussed above. That is, according to the above test, the same invention is not being claimed, and therefore, the rejection should be withdrawn.

Claims 14 and 15 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of US Patent No. 6,399,147. This rejection is respectfully traversed.

Claim 1 of US Patent No. 6,399,147 requires forming a metal film on the surface on a Fe-B-R based permanent magnet by a vapor deposition process. In contrast thereto, claim 14 of the present application requires an interfacial layer with R (rare earth element) atom chemically bonded with a film forming metal atom through oxygen atom. Furthermore, claim 14 has been amended to specify a metal oxide film containing carbon. As such, the amended claims would not have been obvious over claim 1 of U. S. Patent No. 6,399,147.

Claims 14 and 15 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of US Patent No. 6,251,196. Favorable reconsideration of this rejection is earnestly solicited.

Claims 14 and 15 are patentably distinct from the claims of US Patent No. 6,251,196. Claim 1 of US Patent No. 6,251,196 requires a vibrating and/or agitating step which forms a fine powder of a first metal on the magnet. In contrast, amended claim 14 requires forming a metal oxide film containing carbon. Accordingly, the presently pending claims are patentably distinct from the claims of US Patent No. of 6,251,196.

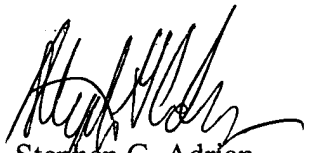
For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action by applicants would be desirable to place the application in better condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP



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PATENT TRADEMARK OFFICE

Enclosure: Version with markings to show changes made

Q:\FLOATERS\SGA\99\991406A\AMENDMENT

VERSION WITH MARKINGS TO SHOW CHANGES MADE 09/977,363

IN THE CLAIMS:

Claims 9 and 14 have bee amended as follows:

9. (Amended) A process for producing a rare earth metal-based permanent magnet, comprising the step of forming a metal oxide film containing carbon on the surface of a magnet by a sol-gel coating process.

14. (Amended) A process for producing a rate earth metal-based permanent magnet, comprising the step of forming a metal oxide film containing carbon on the surface of a magnet by a sol-gel coating process, thereby forming, between said metal oxide film and the entire surface of said magnet, an interfacial layer with R (rare earth element) atom chemically bonded with a film forming metal atom through oxygen atom.